

REMARKS

The Applicant appreciates the courteous and complete examination of the application by the Examiner. In view of the foregoing amendments and the following remarks, a reconsideration of the instant application is respectfully requested.

The Examiner states that the information disclosure statement filed on June 27, 2005 fails to comply with 37 CFR 1.98(a)(2). A copy of each cited foreign patent document is submitted herewith, thereby complying with 37 CFR 1.98(a)(2).

The Examiner objected to the disclosure for informalities. The Applicant respectfully submits replacement paragraphs which correct each informality stated by the Examiner.

In order to expedite the prosecution of this application, claim 4 has been canceled without prejudice or disclaimer of the subject matter thereof, and claims 1-3 and 5-9 have been amended. Claim 10-20 have been added to more completely cover certain aspects of the Applicant's invention. Claims 1-3 and 5-20 are now in this application.

The Examiner objected to claims 5-9 under 37 CFR 1.75(c) as being in improper form. Claims 5-9 have been amended to remove all multiple dependent claim language.

Additionally, the Examiner rejected claims 1-4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 was amended to change the language "if formed" to "is formed". Claim 2 was amended to delete language "for instance". Claim was amended to change the language "if formed" to "is formed". Claim 4 has been cancelled.

Furthermore, the Examiner rejected claims 1-3 under 35 U.S.C. 102(b) as being anticipated by Hardin et al. Independent claim 1 has been amended to incorporate the allowable subject matter of claim 4, as stated by the Examiner on page 4 in the office action dated 11/01/2006. The Hardin et al. reference does not disclose, teach, or suggest the use of a cleaning means to remove debris or dirt from the green restoring tool (12) when moved in or out of the carrier (36). Furthermore, the Hardin et al.

reference makes no provisions for the use of a brush mounted in the interior of the carrier (36).

The Applicant respectfully believes that the Examiner is in error in stating that the opened end (46) in the Hardin et al. reference "is inherently capable of cleaning the tool while the tool is retracted into the carrier.", since the Hardin reference makes no disclosure or suggestion of removing or cleaning debris is mentioned in the reference. The Applicant would like to point out the well known basis of the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See *In re Rijckaert*, 9 F.3d 1531,1534,28 USPQ2d 1955, 1957 (Fed.Cir.1993). Additionally, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " See *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed.Cir.1999).

The Applicant respectfully requests that the Examiner reconsiders his rejections of the invention in additional view of the well established principle that small differences in a crowded art can constitute patentable improvement. See *In re Baum*, 51 USPQ 470 (CCPA 1941) and *In re Lange*, 126 USPQ 365 (CCPA 1960). In considering this principle, the Applicant would also request that the Examiner take note to the court decision which notes that "apparent simplicity has been held to furnish strong argument for patentability where, as here, a need has existed for a structure of the nature disclosed and claimed. The fact that a solution to a problem is simple, or appears to be simple when viewed in retrospect, does not mean that the solution was obvious when it was conceived." See *Ellipse corp. v. Ford Motor Co.*, 171 USPQ 513.

Therefore since independent claim 1 has been amended to include the allowable limitations of cancelled claim 4, and that the Hardin et al. reference relied upon by the Examiner does not disclose, teach, or suggest the specific cleaning means structure, amended claim 1 is believed to be in condition for allowance.

Claims 2, 3 and 5-12 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 1.

Newly added independent claims 13 and 20 are believed to be allowable in that they contain the allowable subject matter of amended claim 1, plus additional limitations not disclosed or suggested in the Hardin et al. reference. Claims 21-19 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from claim 13.

With the above amendments being fully responsive to all outstanding rejections and formal requirements, it is respectfully submitted that the claims are now in condition for allowance, and a notice to that effect is earnestly solicited. Should the Examiner feel that there are further issues which might be resolved by means of telephone interview, the Examiner is cordially invited to telephone the undersigned at (403) 444-5695, or email at davidguerra@verizon.net.

No additional fee is due.

Respectfully Submitted,



David A. Guerra, Reg. 46,443

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On (Date) 01/19/2007 by David A. Guerra

